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A Few Elementary Notes ON THE LAW OF PATENTS

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OF SAN FRANCISCO, CALIFORNIA

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PREFATORY NOTE.

In submitting these brief, fragmentary notes, we feel it our duty to remind the reader that "a little learning is a dangerous thing." As stated in Robinson on Patents: "One of the most common sources of error in all human affairs is the partial statement of a truth. Such a statement is correct as far as it goes, but if adopted and repeated by the hearer as embodying the whole truth, it scatters the seeds of many subsequent mistakes."

The following notes do not purport to represent the whole truth in respect to the topics treated therein. They are intended merely as answers of a general nature to the questions of a general nature most frequently asked us by our clients and by attorneys not specializing in patent law. As a rule, general statements are subject to exceptions. Therefore, a correct and comprehensive answer to a particular question requires a comprehensive knowledge of all the facts and circumstances upon which the question is based. Nevertheless, these notes may prove of some value to those interested in patents, although they are not intended to be acted on by anyone without the advice of a patent attorney.

WILLIAM K. WHITE.
HUBERT G. PROST.

San Francisco, California,
September, 1917.



A Few Elementary Notes on the Law of Patents

Abraham Lincoln once said that the American patent system is intended to "add the fuel of self-interest to the fire of genius."

Preliminary Remarks.

The power of the United States to grant to inventors certain exclusive privileges is derived from the following clause in the eighth section of the first article of the Constitution:

"The Congress shall have power . . . to promote the Progress of Science and Useful Arts, by securing, for limited Times, to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Acting under such authority, Congress has passed four Acts, which have in turn been the basis of our entire patent system; the Acts of 1790, 1793, 1836 and 1870. The Act of 1870 became the basis of the present provisions of the Revised Statutes controlling patents.

Under the English kings, various monopolies were granted to individuals by public letters addressed to the general public. From the Latin name of these letters, "literæ patentes" is derived "letters patent," meaning open letters or letters addressed to the public. It is by such "letters patent" that the United States grant certain exclusive privileges to inventors.

Section 4886 of the Revised Statutes of the United States provides that:

What Inven-tions are Pat-entable.

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

A patent for an invention is a contract between the party claiming to be the inventor thereof and the Government. In consideration of the inventor disclosing his invention to

Patent Defined.

the public, the Government grants him, for the period of seventeen years, the right of preventing all others from making or using or selling his invention. At the end of such seventeen years monopoly, the public is free to make, use or sell the invention. It is to be noted that an United States patent grants *no* right to make, use or sell anything; it grants only the right of preventing all others in the United States from making, using or selling the invention covered thereby.

The law does not require the owner of a patent to make any use of the invention covered thereby. If the patent owner so desires, he may refrain from making, selling or using any device embodying the patented invention and, at the same time, prevent all others from making, selling or using such devices.

Inventors.

"The right of property which an inventor has in his invention, is excelled, in point of dignity, by no other property right whatever. It is equaled, in point of dignity, only by the rights which authors have in their copyrighted books. The inventor is not the pampered favorite or beneficiary of the government, or of the nation. The benefits which he confers are greater than those which he receives. He does not cringe at the feet of power, nor secure from authority an unbought privilege. He walks everywhere erect, and scatters abroad the knowledge which he created. He confers upon mankind a new means of lessening toil, or of increasing comfort; and what he gives cannot be destroyed by use, nor lost by misfortune. It is henceforth an indestructible heritage of posterity. On the other hand, he receives from the government, nothing which cost the government or the people a dollar or a sacrifice. He receives nothing but a contract, which provides that for a limited time he may exclusively enjoy his own. Compared with those who acquire property by devise or inheritance; compared with those who acquire by gift or marriage; compared with those who acquire property by profits on sales, or by interest on money, the man who acquires property in inventions, by creating things unknown before, occupies a position of superior dignity. Even the man who creates value by manual labor, though he rises in dignity above the heir, the donee, the merchant, and the money-lender, falls in dignity below the author and the inventor. The inventor of the reaper is entitled to greater honor than his father who used the grain cradle, and the inventor of the grain cradle is entitled to greater honor than his ancestor, who, for a hundred generations, had

used the sickle. Side by side stand the inventor and the author. Their labor is the most dignified and the most honorable of all labor; and the resulting property is most perfectly theirs.”¹

As said by Francis Bacon:

“Now among all the benefits that could be conferred upon mankind, I discovered none so great as the discovery of new arts for the bettering of human life. For I saw that among the rude people of early times, inventors and discoverers were reckoned as gods. It was seen that the works of founders of States, law-givers, tyrant-destroyers, and heroes cover but narrow spaces, and endure but for a short time; while the work of the inventor, though of less pomp, is felt everywhere, and lasts forever.”

“Inventive genius has given to mankind most of its present material civilization. The magnificent flower of civilization, everywhere surrounding us, has opened from germs that were fructified from the brains of inventors.”²

An invention is an idea of means for accomplishing an ^{Invention.} end. The inventive act is completed when the mental conception of an idea of means is followed by the embodiment of such idea of means in concrete form. Such concrete embodiment of the idea of means is termed a reduction to practice of the invention. The filing of a patent application is called a *constructive reduction to practice* of the invention disclosed therein and, for some purposes, is deemed the equivalent of an actual reduction to practice.

There is no idea that cannot be verbally expressed in a number of ways, each expression thereof being the equivalent of every other expression of the same idea. This is universally true. For instance, the idea that an object is round can be expressed in a number of ways. The same idea may be expressed thus: “Every point on the object’s surface is equally distant from the center of the object.” The same idea may be expressed in any of the foreign languages.

It follows there can be no *generic expression* of a generic idea. Every *expression* of a generic idea is only one of many possible *specific expressions* of such idea.

The foregoing is true in connection with practically all mechanical inventions which may be expressed by the use

¹ Walker on Patents.

² Judge Grosscup.

of mechanical elements. Where an inventor conceives an *idea of means*, it is almost always possible to express said *idea of means* in many different concrete forms, each the equivalent of every other. For instance, an inventive idea of means might be expressed or embodied in a machine, in which a *weight* is used for returning a movable part to normal position. However, such specific embodiment of the generic *idea of means* would constitute only one species of the invention. It is obvious that, in most cases, a *spring* could be substituted for the *weight* to perform precisely the same function in the machine. The machine, with a *spring* so substituted therein for the *weight*, would constitute another *species* of the generic invention.

In the law of patents, said *weight* and *spring* would be termed "mechanical equivalents"; and the machine, with the *weight* therein, and the machine, with the *spring* therein, would be *equivalent* expressions or concrete embodiments of the same inventive idea of means.

Letters Patent.

The value of a patent, on an invention, depends on whether or not it covers the *actual* invention, in *whatever form it may be expressed or embodied*. The patent may be so worded as to cover only one, of many forms, in which the invention can be embodied. In such a case, the inventor practically dedicates to the public his whole invention, because the public, without infringing the patent, may freely use the invention when expressed or embodied in any of the equally valuable forms not covered by the patent.

From the foregoing, it will be seen that an inventor may make an invention of great value and yet fail to derive any profit therefrom by reason of filing a patent application so drawn as to cover only one specific embodiment of his broad invention.

The commercial value of a patent, therefore, depends upon two factors:

1st. Upon the commercial value of the actual invention disclosed therein in respect to supplying a public want or need.

2nd. Upon the patent covering and protecting the *actual* inventive idea of means in every equivalent form in which the same can be embodied.

A patent on an inventive idea of means, capable of embodiment in a machine, comprises a document containing:

1. Drawings illustrating one form of machine in which the invention may be embodied. (Note: The Patent Office Rules do not permit one to attempt to illustrate all or a number of the various modified forms of machines in which the invention can be embodied.)

2. A specification constituting a description of the machine, shown in the drawings.

3. Claims.

The "claims" are the most important part of a patent. Claims. The breadth and scope of the monopoly, granted by the patent, depend upon the wording of the claims. The claims define the metes and bounds of the invention of which a monopoly is granted to the inventor.

A patent grants a monopoly of only that which is *claimed*. A deed to land grants only that which lies within the metes and bounds set forth in the deed.

A patent may disclose, in the drawings and specification thereof, a broad, pioneer invention. However, the *monopoly*, granted by such patent, may be only one specific embodiment of such invention, by reason of the inventor failing to *claim* all that he was entitled to claim.

A chain is no stronger than its weakest link; a patent claim is no broader than its narrowest limitation.

What can be but is *not claimed* in a patent, is dedicated to the public.

Each claim of a patent is, in effect, a patent on the subject matter thereof. One claim may be valid and another claim, in the same patent, be invalid. One claim may be infringed and another claim, in the same patent, be not infringed by the unlicensed manufacture, sale or use of a particular machine.

A claim, specifying a number of elements combined together in a combination, is frequently termed a "combination claim." The law presumes each of the elements, so specified in a combination claim, to be old. The inventive act, in creating the novel combination so claimed, consists in bringing together, in cooperative relation, the various elements specified in the claim. The invention, covered by a combination claim, is the combination considered as an unity distinct from the elements composing it. Such a combination may be novel notwithstanding each of the elements thereof is old.

Combination
Claim.

A poet is entitled to copyright his poem notwithstanding

it is merely a novel combination of words each of which is old and may be found in the dictionary. The poet's creative work consists in bringing together, in a new relation, a number of old words. The combination of words, constituting a poem, is considered as an unity distinct from the words of which it is composed.

There is a close analogy between the creative work of the poet and the creative work of the inventor. The poet may express his ideas in new combinations of old words. The inventor may express his ideas in new combinations of old mechanical elements. In the one case, it is the new combination of words of which a monopoly is granted by the copyright. In the other case, it is the new combination of mechanical elements of which a monopoly is granted by the patent.

A copyright on a poem does not grant a monopoly of the various words thereof, separately considered apart from the combination thereof constituting the poem. A patent on a novel combination of mechanical elements does not grant a monopoly of the various elements thereof, separately considered apart from the combination thereof constituting the invention.

Patent Office Rule 17 reads as follows:

Patent Office
Advice Re-
garding Patent
Attorneys.

"An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent patent attorney, *as the value of patents depends largely upon the skillful preparation of the specification and claims.* The office can not aid in the selection of an attorney. . . ."

Patent Application.

The first step taken to obtain a patent is the filing of an application therefor in the United States Patent Office at Washington, D. C. The government fee for filing an application is \$15.00.

The application for a patent on an invention, capable of embodiment in a machine, comprises a document containing:

- 1st. The inventor's formal petition for the grant of a patent.
- 2nd. Drawings illustrating one form of machine in which the invention may be embodied.
- 3rd. A specification constituting a description of the machine shown in the drawings.
- 4th. Claims.

5th. The inventor's oath as to being the inventor.
 The Supreme Court of the United States, in the case of Skill Required
in Writing
Application. *Topliff v. Topliff*, 145 U. S., 169, said:-

"The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention."

No model of a machine is required to be filed with the Model. application for a patent thereon. Furthermore, it is not necessary to make a machine or any model thereof, before applying for a patent thereon.

However, the making, use or sale of a machine for a period of *less* than two years before the filing of an application for a patent thereon is no bar to the grant of a patent thereon. It is, nevertheless, advisable for an inventor to file his application as soon as possible after the perfection of his invention.

If the application, as filed, be allowed without objection, Prosecution of
Application. a patent issues thereon. Such a patent contains an exact copy of the drawings, specification and claims forming a part of the application as filed.

As a general rule, applications are not allowed as filed.

Upon the receipt of the application, by the Patent Office, it is dated and given a serial number. A notice of such date and serial number is immediately sent to the applicant's attorney. The application is then sent to the classification department, wherein it is briefly examined to determine the art to which the invention relates, and from there it is sent to the proper examining division. There are forty-three examining divisions, in charge of each of which there is an examiner, and his assistant examiners. In 1916, there were three hundred and thirty-four assistant examiners actively engaged in considering applications.

In each examining division, the applications are examined in the order of their respective filing dates. By reason of the examiners being insufficient in number to

promptly consider each application, an application is not acted on, as a general rule, until about four months after the filing of the same in the Patent Office. In many instances, the first action on the application is delayed for a much longer period.

Such a delay, in the first consideration of his application, often works a great hardship on the inventor because, until said first action, he is left in the dark as to the attitude of the Patent Office toward his application. To remedy delays of this kind, it will be necessary for Congress to increase the Patent Office examining corps.

Upon his first consideration of an application, the Examiner reads it for the purpose of detecting any errors therein and in order to acquaint himself with the invention therein disclosed. The claims therein are then considered and allowed or rejected according to the Examiner's opinion as to the patentability of the subject-matter thereof. Ordinarily, on the first action, some claims are allowed and some are rejected.

The action of the Examiner is communicated to the applicant's attorney in the form of a letter, setting forth any corrections required to be made in the application and specifying the claims, if any, allowed and the claims, if any, rejected, together with his reasons for so rejecting them.

To be patentable, the subject matter of a claim must be novel, useful and the result of an inventive act as distinguished from the product of mere mechanical skill.

Whether the production of a particular novel thing required the exercise of the inventive faculties or required the exercise of only mechanical skill, raises a question often difficult of determination and concerning which Courts, patent office tribunals, mechanical experts and patent attorneys frequently hold widely divergent views and opinions. There are many patents which have been adjudged valid by some courts and invalid by others, by reason of a difference of opinion on this question of invention.

In determining the question of the novelty of the subject matter of a claim, the Examiner is entitled to refer to the whole prior art as disclosed in prior patents and prior printed publications. If the subject matter of the claim is found disclosed in any such prior patent or publi-

cation, the claim is rejected and, therefore, it frequently happens that the rejection of a claim is based upon some prior United States patent, or upon some prior British, French, German, Swiss, Swedish, Norwegian or other foreign patent or upon some prior text-book, catalogue or other printed publication which may have been published in this or any foreign country hundreds of years prior to the date of the application.

When an applicant learns that his invention is described in a book published hundreds of years before, he is very apt to approve of the following sentiment:

“Confound those thieving ancients who are always stealing our modern ideas.”

Frequently a rejection is based upon the Examiner's contention that the invention is merely a combination of two or more disclosures respectively found in two or more prior patents or publications and that the combination, by the applicant, of such disclosures in one machine or device did not require invention but only mechanical skill.

On receipt of the Patent Office letter, containing the Examiner's action, the applicant's attorney is compelled to examine any prior patents or publications, cited by the Examiner as the basis for his action, and determine whether or not the Examiner's action is justified and proper.

If the applicant's attorney agrees with the Examiner's views, the rejected claims are immediately cancelled or amended in accordance with the Examiner's suggestions made in connection with his rejection of the claims.

If the applicant's attorney is of the opinion that the Examiner's action is improper and not justified by the references cited by him, the attorney replies to the Patent Office action by sending a letter containing an argument pointing out the error of the Examiner's position. In response to such argument, the Examiner again acts on the case and the attorney is entitled to again reply to such action and so on until the Examiner either finally allows or finally rejects all of the claims contained in the application as filed or thereafter inserted therein from time to time by way of amendment of the application. Some of the claims may be finally allowed and some finally rejected. From such a final rejection, an appeal may be taken

through the various Patent Office tribunals and finally to the Court of Appeals for the District of Columbia.

In some cases of a complex nature, the actions of the Examiner and the attorney's replies thereto are very numerous and extend over a period of years. A copy of the application as filed, together with a copy of all said actions and replies thereto, and of the patent, as finally issued, constitute what is termed the "File Wrapper Contents of the Patent."

The broadest claims of a patent are the ones that cover the very essence of the invention stripped of every non-essential feature. As a rule, the broadest claims in an application are the ones most frequently rejected and the most difficult to get allowed. Such a situation is attributable to various reasons which cannot be properly set forth in these brief, elementary notes.

The narrow claims of a patent are those that cover the specific embodiment of the invention in that particular form deemed by the inventor to be the best or preferable form and, therefore, a form containing valuable but not necessarily essential features. In other words, the so-called "preferable" form of embodiment is usually a machine containing valuable features, one or more of which can be dispensed with and the machine, nevertheless, successfully perform its functions even though less perfectly or economically.

It is most important for an inventor to appreciate the work done by his patent attorney after the filing of the application. As above indicated, the prosecution of the application to an allowance usually involves a great deal of hard, conscientious work and often embraces numerous and lengthy arguments based upon a detailed consideration of a great many prior patents and publications cited by the Examiner as the basis for his actions. It is a conservative statement to say that it is the rule and not the exception for an Examiner to finally allow claims in an application which were first rejected by him, and such allowance is due to the persuasive and convincing arguments presented by the applicant's attorney.

It is most important for an inventor to appreciate the fact that "the line of least resistance" for his attorney to follow is to always acquiesce in the Examiner's contentions and, without argument or contest, accept whatever

the Examiner, in the first instance, is willing to allow. To follow such "line of least resistance" means a sacrifice of the inventor's rights and property, but it also means less work and trouble on the part of his attorney, and the inventor should be keenly alive to such situation. If an inventor expects to secure a patent granting him a monopoly as broad as his invention, he should expect to and be willing to compensate his attorney for vigorously prosecuting the application and conscientiously presenting every point and argument in favor of the allowance of every claim which, in the attorney's opinion, has been improperly rejected.

It is also important for the inventor to appreciate the value of securing an allowance of not only broad claims but also narrow claims covering his preferred form of embodiment of his invention. Narrow claims are limited to and include features not called for by the broad claims. It is, therefore, much easier to anticipate a broad claim or, in other words, find in the prior art, a disclosure of every feature called for by such broad claim. Even though such prior art disclosure contains every feature mentioned in the broad claim, it may not contain the additional features included in the narrower claims and, therefore, will not be an anticipation of such narrower claims. Of course, the subject-matter of a claim is not novel, if all the features of such subject-matter are found disclosed and described in some prior patent or publication. When the subject-matter of a claim is so found in a prior patent or publication, said prior patent or publication is called an anticipation of the claim and invalidates the claim for lack of novelty.

The prosecution of an application continues until all of the claims, remaining in the application, have been allowed and thereupon the application, as a whole, is allowed. Within six months after the allowance of the application, the Government issuance fee of \$20.00 must be paid to the Patent Office. The letters patent are issued about three weeks after the payment of such fee, usually termed the "final fee."

In passing on an application, the Patent Office does not consider the question of infringement,—that is, whether or not the manufacture, sale or use of the device, disclosed in the application, will constitute an infringement

Issuance of Patent.

Question of Infringement
Not Considered
by Patent Office.

of some prior patent. The prior patents are examined for the purpose of ascertaining whether or not the subject-matter of the application is novel,—that is, whether or not it is disclosed in such prior patents.

Examples Illustrating Some Elementary Principles of Patent Law.

By reference to the assumed development or evolution of such a simple “idea of means” as is embodied or concretely expressed in a chair, we shall now illustrate a few of the elementary principles of patent law. It is to be understood that our illustrations are not intended as correct examples of any patent law principles other than those specifically mentioned in connection therewith. Questions of general patentability, invention, aggregation, double use, etc., etc., are not taken into account in giving such illustrations.

Generic Idea of Means.

1. Let us assume that chairs had never been provided with casters on the legs thereof and that one, Jones, was the first in the art to conceive the idea of combining any type of chairs with any type of casters. Such a conception would be a broad, generic abstract idea of means or generic invention. In applying for a patent on said invention, it would be impossible for Jones to illustrate, in his application, all kinds and types of casters and all kinds and types of chairs, yet his “idea of means” is sufficiently comprehensive to embrace the combination of every type of chair with every type of caster, and, therefore, he would be entitled to a patent covering the combination of any type of chair with any type of caster.

Best or Preferred Form of Embodiment of Idea of Means.

2. To secure a patent covering broadly his generic invention, Jones would be compelled to comply with the law and disclose, in his application, the preferred or best form of embodiment of his broad invention. Such preferred form would necessarily be only one specific embodiment or *species* of the generic invention. Let us assume Jones selects an *arm* chair combined with casters as the best or preferred form in which to embody or express his idea of means.

In his application drawings, he would illustrate an *arm* chair provided with casters and, in the specification forming a part of his application, he would describe such *arm* chair with casters on the legs thereof.

Generic and Specific Claims.

3. Being the first in the art to combine any type of chair with any type of caster, Jones would be entitled to a generic “claim” as broad as his novel combination.

Being the first in the art to combine an *arm* chair with any type of caster, Jones would be entitled to a specific "claim" *limited* to such specific combination.

a. Generic Claim: In combination, a chair and casters attached to the legs thereof.

b. Specific Claim: In combination, a chair, arms arranged above and at the sides of the seat thereof and casters attached to the legs thereof.

4. The relative values of broad, generic claims and of narrow, specific claims are due to the principles of law relating, respectively, to questions of *infringement* and of *anticipation*.

A claim calling for three elements *is not* infringed by the unlicensed manufacture or sale or use of a device containing only two of said elements.

A claim calling for three elements *is* infringed by the unlicensed manufacture or sale or use of a device containing said three elements plus one or more additional elements.

A claim calling for three elements is not anticipated by a prior device containing only two of said elements.

(Note: Like all general rules and statements, the foregoing are subject to exceptions, which cannot be set forth in such an elementary discussion as this.)

Jones' specific claim, calling for three elements, to wit: (1) a chair, (2) arms thereon, and (3) casters attached to the legs thereof, would not be infringed by a person, without license, making, or selling, or using a chair provided with arms but not with casters or provided with casters but not with arms. Such a chair would not embody the invention covered by such specific claim, because it lacks one of the three elements mentioned in the claim and by such mention therein, made an *essential feature* of the invention covered by the claim.

Jones' generic claim calling for only two elements, to wit: (1) a chair, and (2) casters attached to the legs thereof, would be infringed by a person, without license, making or selling or using a chair provided with casters but not with arms, because such claim does not call for "arms" or make "arms" an essential feature of the invention by mentioning arms as an element of the combination covered by the claim.

However, said generic claim, calling for two elements, would be infringed by a person, without license, making, selling or using a chair provided both with arms and casters because such a chair would embody the two elements of the claim notwithstanding it also embodied, in addition, a third element, to wit: arms.

From the foregoing, it is apparent that the said specific claim could not secure to Jones complete protection for his actual invention, because anyone, without infringing said claim calling for three elements, could make, sell and use chairs provided with casters even though they could not lawfully provide such chairs having casters with the third element of the claim, to wit: arms.

If Jones only claims the combination of casters with a chair provided with arms, he, in effect, dedicates to the public the right to combine casters with all types of chairs, other than chairs provided with arms, notwithstanding he was the first, in the art, to combine casters with any and all types of chairs, and, therefore was entitled to a monopoly of such broad combination.

In view of the foregoing, it is seen that the more elements called for or specified in a claim, the narrower the claim becomes. A claim for two elements is broader than a claim specifying said two elements plus one or more additional elements. A claim by specifying or calling for twenty elements, makes every one of said elements an essential feature of the combination or invention covered by the claim. Nineteen of said elements can be used without infringing the claim.

(Note: Questions, relating to mechanical equivalents, to the substitution of equivalents, and to "mode of operation" are not taken account of in the foregoing remarks.)

Anticipation.

5. If, after the granting of a patent to Jones, it is discovered that a chair, *without arms*, but provided with casters, is described in a prior printed publication, Jones' generic claim would be anticipated by such prior disclosure and therefore void, because Jones could not be deemed the first inventor of a combination described in a publication published before he thought of making such combination.

However, such a prior publication would not anticipate Jones' specific claim calling for a third element, to wit:

"arms," because no arms are referred to or described in such prior publication, and, therefore, the same does not show that Jones was not the first one in the art to apply casters to an *arm* chair. Therefore, the specific claim would not be invalidated by such prior publication.

The foregoing illustrates the value of obtaining narrow, specific claims as well as broad, generic claims.

6. Let us assume one Smith improves on Jones' invention by adding anti-friction rollers to the casters attached to the legs of a chair and that such rollers are provided with ball-bearings. Smith would be entitled to a patent on his improvement and could word his claims thereon, as follows:

Generic Claim: In combination, a chair, casters attached to the legs thereof and anti-friction rollers applied to said casters.

Specific Claim: In combination, a chair, casters attached to the legs thereof, anti-friction rollers applied to said casters and ball-bearings for said rollers.

7. Smith, without a license from Jones under the Jones patent, could not lawfully make, use or sell a chair embodying the Smith improvement, because, in so doing, he would infringe the prior Jones patent covering a chair + casters. In other words, Smith, in order to use his own invention, embracing a chair + casters + anti-friction rollers, would be compelled to use the Jones invention embracing a chair + casters. However, the prior Jones patent grants to Jones the right of preventing all others from making, selling or using a chair + casters and, therefore, Jones, under his patent, could enjoin Smith from making, using or selling a chair + casters + anti-friction rollers.

Infringement
by Use of
Patented
Improvement.

On the other hand, the subsequent Smith patent grants to Smith the right to prevent all others from making, using or selling a chair + casters + anti-friction rollers. Therefore, Smith could enjoin Jones from adding anti-friction rollers to the Jones patented combination of a chair + casters.

8. The foregoing illustrates the fact that the grant of a patent is not the grant of the right to make, sell or use devices embodying the invention covered by the patent. The right, granted by a patent, is only the right of preventing all others from making, selling or using devices embodying the invention covered by the patent.

Nature of
Patent
Monopoly.

Smith would not have the right to embody his own patented improvement in a chair structure until after the expiration of the Jones patent giving Jones the monopoly of two of the elements employed by Smith in Smith's improved device.

Until after the expiration of the Smith patent, giving Smith a monopoly of anti-friction rollers used with the combination of a chair+casters, Jones would have no right to apply such anti-friction rollers to the Jones patented combination of a chair+casters.

Reason Why
Infringement
Not Considered
by Patent
Office.

9. The foregoing situation illustrates the reason why the Patent Office does not consider the question of infringement in passing on an application for a patent.

The patentability of Smith's improvement on Jones' prior patented invention does not depend on whether or not such Smith improvement can be made, sold or used without infringing Jones' patent. If the Smith improvement is novel, useful and the product of an inventive act, Smith is entitled to receive a patent thereon.

The granting of such a patent to Smith does not conflict with the monopoly granted by the Jones prior patent. Jones is still free to make, sell, and use the combination of a chair+casters. The Smith patent monopoly merely enables Smith to prevent Jones and everyone else from adding anti-friction rollers to the Jones combination.

Let us assume Smith inserted, in his application, the following claim:

"In combination, a chair and casters attached to the legs thereof."

In considering the *novelty* of such claim, the Examiner would search the prior art and run across the prior Jones patent. On finding disclosed, in the Jones patent, the combination of a chair+casters, he would reject such Smith claim on the Jones patent, as the same shows Smith was not the first one in the art to combine a chair and casters, and, therefore, was not the original and first inventor of such a combination.

However, the Jones patent would not prevent Smith from securing a claim covering the combination of a chair+casters+anti-friction rollers, because Jones does not disclose any anti-friction rollers in his patent. The fact that the Jones patent *claims* the combination of a chair+casters

does not affect the *novelty* of Smith's combination of a chair+casters+anti-friction rollers.

10. The fact that Smith cannot lawfully make, sell or use his patented improvement does not necessarily make his patent valueless. If Jones wishes to use anti-friction rollers, in the Jones patented combination, he may be willing to either purchase the Smith patent or take a license thereunder from Smith on a royalty basis. On the other hand, Smith may be able to purchase the Jones patent or take a license from Jones, and thereby be in a position to lawfully exploit his own patented improvement. A third party may be willing to purchase both patents in order to exploit the inventions respectively covered by them.

As heretofore stated, the foregoing claims are not intended as correct examples of all patent law principles. For instance, the validity of the claim for a chair+casters might be attacked on the ground that no invention was required to first apply casters to a chair. Assuming that casters had been previously applied to a table, the subsequent application of casters to a chair might be adjudged a mere "double-use" or more extended use of casters and the Courts usually hold that such a mere "double-use" of a device does not amount to invention. The validity of the claim for a chair+arms therefor+casters might be attacked on the ground that there was no cooperation between the arms and casters and, therefore, the claim was for a mere aggregation of elements and not for a true patentable combination. The claim for a chair+casters+anti-friction rollers+ball-bearings might be rejected by the Patent Office on the ground that the real invention was an improved form of caster, adaptable for use with various articles and, therefore, the chair should not be made an element of the claim.

The monopoly, granted by a patent, is one entire thing and cannot be divided into parts except as authorized by the patent laws.

The patentee may, by an instrument in writing, assign 1st, the whole patent, comprising all the rights thereby granted; or 2nd, an undivided part or share of all such rights; or 3rd, all the rights under the patent within and throughout a specified part of the United States.

An assignment, grant or conveyance of a patent or of any such interest therein, should be recorded in the

Value of Improvement Patent.

Exemplar Claims Considered in Light of Other Patent Law Principles.

Transfer of Patent Rights.

Patent Office within three months after the execution thereof.

A transfer of any lesser rights under a patent is a mere license.

Protection of
Patent Rights.

Patent rights may be protected by a suit brought in some United States District Court for the infringement of the patent. In an action at law, the case may be tried before a jury and the plaintiff be awarded the damages suffered by reason of the defendant's infringing acts. The Court may, within its discretion, treble the actual damages so awarded. In a suit in equity, the plaintiff, in addition to recovering any damages suffered or any profits realized by the defendant by reason of the infringement, may obtain an injunction restraining the further manufacture, sale or use of the infringing device.

It is to be noted that the *use* of an infringing device may be enjoined, as well as the manufacture and sale thereof.

A Few Facts Pertaining to Patents

The term or life of a United States patent is seventeen years, commencing on the date of issuance of the patent. On January 1, 1917, the United States had issued 1,211,380 patents, of which 594,509 were then unexpired. Patents now are issuing at the rate of 45,000 a year and this rate is constantly on the increase.

The State of California is well to the front in respect to the number of patents issued to its residents in proportion to its population. In the year 1915, California residents received patents in the ratio of 1 patent to every 1224 of the State's population. In the same year, the New York ratio was 1 to 1386; the Pennsylvania ratio was 1 to 1945, and the Mississippi ratio was 1 to 17,447. These figures entitle California to lay claim to being a land of invention as well as a land of sunshine, fruit and flowers.

The value of patents is fully recognized by the largest manufacturing concerns of the country and many of them maintain elaborately equipped experimental and research laboratories and patent departments for the development and protection of new inventions.

To keep abreast of the progress being made in its particular line of industry, it is customary for such a concern to secure, as soon as issued, all patents pertaining to such industry.

Infant industries receive more protection from patents than they do from high tariffs and to such patent protection is due the present wealth and prosperity of some of the greatest manufacturing organizations of the country.

To the manufacturer, the value of patent protection is twofold. After expending thousands, and sometimes hundreds of thousands of dollars, in developing some new type of machine or apparatus, it is absolutely essential for him to secure patent protection thereon in order to enable him to obtain an adequate return on his original investment in such experimental work. Without such protection, he would be compelled to immediately meet the competition of others who, unburdened by the expense of developing the machine, could duplicate it and sell it at a price sufficient to yield them an ordinary profit but insufficient to yield the developer thereof any returns on his development expenditures.

From the manufacturer's standpoint, patents are also a species of insurance against possible litigation. When the manufacture of any new or modified form of machine or device is commenced, it is most important for the manufacturer thereof to carefully

consider the possibility of securing patent protection therefor even though, in his opinion, the exclusive right of making the machine may be of little value to him. If he fails to file an application for a patent on such new machine or device he may be confronted with the following and not uncommon situation.

Years after commencing the sale thereof, he is notified that the machine infringes a patent applied for months and possibly a year or more after he first placed the machine on the market. The application for such patent may have been pending in the Patent Office for a number of years and under the law, the validity of the patent is not affected by anything done by the manufacturer after the filing date of the application. To prove that he was the first to make the patented machine, the manufacturer is compelled to prove what he did in that regard prior to the application filing date. If said date be five or more years prior to the time his attention is first called to the patent, the difficulty of making such proof is apparent. The drawings and patterns, used in making his first type of machine, may have been lost: the manufacturer may not be able to locate any of the first machines sold by him and his later machines may differ therefrom in form if not in principle. He is, therefore, confronted with the necessity of basing his proofs on the oral testimony of witnesses attempting to remember the details of construction of a type of machine made years before and such character of proof is always deemed unsatisfactory and of little weight. The manufacturer, therefore, may be held an infringer of a patent covering a machine which was, in fact, first developed by himself, but which fact he is unable to prove by sufficient evidence.

The foregoing and not unusual predicament could have been avoided by the manufacturer, if he had filed an application for a patent on his machine as soon as the same was perfected. Such an application would be record evidence of his activities and, in the event of another party filing an application disclosing a similar machine, an interference would be declared by the Patent Office between the applications, and the question of priority of invention be at once determined and the patent be issued to the first inventor. Furthermore, the necessity of proving, in such an interference proceeding, that he was the first one to invent the machine, would usually arise very soon after the manufacture and sale of his first machine and, therefore, the manufacturer then would be in a position to produce

sufficient proofs of that fact which, many years thereafter, might not be available to him.

In view of the foregoing, the manufacturer of any new or modified type of machine or device should look upon the filing of an application for a patent thereon as a form of insurance against infringement suits, and very cheap insurance at that.

In view of the large number of patents being issued annually, it is to be expected that a large proportion of them cover inventions of no great value. Of course, the value of a patent depends primarily upon the value of the invention disclosed therein. The issuance of a patent thereon, does not increase the intrinsic value of an invention. The fact, therefore, that many patents are of no value, because the inventions respectively covered thereby, are practically worthless, should not influence one to consider all patents poor investments.

There is no form of investment that yields a larger return than a broad patent on an invention that supplies a general public want or need. Furthermore, the monopoly granted by such a patent is given ample protection by the courts. Nine times out of ten, the man who complains about the lack of protection given patent rights, is the owner of a patent having no value by reason of not disclosing an invention having any value or by reason of being based on an application improperly and unskillfully prepared.

Before investing in a patent, one should obtain expert advice; 1st, in respect to the intrinsic value of the invention disclosed, and, 2nd, in respect to the value of the patent claims as a grant of a monopoly of the *whole* invention. As stated before, a patent may disclose a valuable invention, but not properly or completely claim it; and the scope of the monopoly, granted by the patent, depends primarily upon the claims of the patent and not upon what is disclosed in the drawings or is described in the specification of the patent.

Furthermore, it is the *commercial* value of the invention that should be investigated. A patent may cover a wave-motor which operates successfully but, nevertheless, is a *commercial* failure due to the fact that power can be generated more cheaply by the use of oil or coal. It is estimated that the new steam plant of the Buffalo General Electric Co. at Tonawanda, N. Y., will generate electricity from coal more cheaply than can be done from the waters of Niagara Falls.

The importance of maintaining a patent system which affords the inventor ample protection and which, in fact, does "add the

fuel of self-interest to the fire of genius," was well expressed by Mr. Edmund Wetmore of New York in his address before a recent meeting of the American Bar Association. Mr. Wetmore closed his address with the following remarks:

"The fact that patent laws are primarily for the benefit of the public and not to make inventors a favored class is not as widely understood as it should be. Patents are granted to encourage the making of inventions and to insure their finally becoming public property instead of remaining secrets or being lost or forgotten. And this can only be accomplished by an efficient patent law. This was admirably shown by Mr. Fish in his paper read at the last meeting of the Association, in which the point was strikingly illustrated by the instances of those countries that had reinstated their patent laws after the experiment of abolishing them. A study of facts and statistics will show that patented inventions lie at the bottom of the conveniences, the comforts and the opportunities of our present mode of life, and without which our civilization would cease to advance. Appealing to considerations that come home to all, the influence of patented inventions tends directly to bring down the cost of living in the three essential particulars of rent, food and clothing. As to rent and food, because of the vast extension which patented inventions have produced in the facilities for transportation, whereby not only are the regions which constitute the suburbs of our great cities brought within easy reach of the centers of trade and the source of employment, but long distance transportation, particularly as to food products, opens up the regions where there may be a surplus to those in which there is a deficiency; and as to the matter of clothing, the numerous and accumulated inventions relating to the machinery employed in the production of clothes tend to bring the price of actual necessary clothing down to the lowest figure.

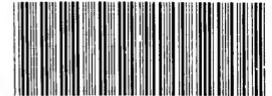
"Examples of the public benefit derived from patented inventions, familiar enough to those who have studied the subject, might be multiplied indefinitely for the purpose of bringing that fact home to those who have not given it sufficient consideration, and as to the enormous results which follow from inventions originally protected by patents, a more striking instance cannot be found than that shown in the present gigantic war. There are three inventions which in a large measure control the conflict and have changed the whole art and strategy of war, namely, the aeroplane invented and patented by the Wrights, the automobile covered by numerous patents, the wireless telegraphy of Marconi—not to speak of the inventions relating to artillery, heavy and light, to the machine gun and to the rifle, some of which have been kept as government secrets, but the majority of which have been patented in the country of their origin.

"These, as it seems to me, are some of the topics by which

a public feeling may be aroused that must in the end check ill-considered legislation directed against our patent system, and which, if unchecked, would gradually destroy it by piecemeal."



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